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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 126726-1/YOD/FAR (GERD:0778)			
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		First Named Inventor  John W. Carbone			
		Art Unit  3627	Examiner  Sheikh, Asfand M.		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. 59,991 Registration number _____  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="width: 50%; vertical-align: top; text-align: center;"><u>/Floron C. Faries/</u> _____ Signature <u>Floron C. Faries</u> _____ Typed or printed name  <u>281-970-4545</u> _____ Telephone number  <u>July 21, 2008</u> _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. 59,991 Registration number _____  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>/Floron C. Faries/</u> _____ Signature <u>Floron C. Faries</u> _____ Typed or printed name  <u>281-970-4545</u> _____ Telephone number  <u>July 21, 2008</u> _____ Date
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.					

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John W. Carbone et al.

Serial No.: 10/064,665

Filed: August 5, 2002

For: System and Method for Providing  
Asset Management and Tracking  
Capabilities

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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Group Art Unit: 3627

Confirmation No.: 5321

Examiner: Sheikh, Asfand M.

Atty. Docket: 126726-1/YOD/FAR  
GERD:0778

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July 21, 2008

Date

/Floron C. Faries/

Floron C. Faries

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In light of the following remarks, Appellant respectfully requests review of the Final Rejection in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. In the Final Office Action, the Examiner rejected claims 1-50. Claims 1 and 26 are independent.

**Legal Error of Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected independent claims 1 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Marsh (U.S. Publication No. 2003/0023517, hereinafter “Marsh”) in view of Maltseff (U.S. Publication No. 2002/00997282, hereinafter “Maltseff.”

***Legal Precedent***

The burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103 falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case of obviousness, the Examiner must show that the combination includes *all* of the claimed elements, *and* also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

***Deficiencies of the Rejection***

The Examiner rejected the only two independent claims 1 and 26 based on the combination of Marsh and Maltseff. Applicants initially stress that the cited combination does not teach or suggest all of the elements of claims 1 and 26. For example, the central tax information database 18 of Maltseff is *not* an asset management system, as apparently alleged by the Examiner. *See* Final Office Action, page 5.

Second, contrary to legal precedent, Applicants believe there is no appropriate reason, much less feasible, to modify Marsh to separate the Marsh components, as apparently proposed by the Examiner. Indeed, the “transmission device” of Marsh, which is referred to in one single passage in paragraph 21 of the reference, is said to be “advantageously connected” to the computing device, apparently within the field control device 110. No other description or qualification is made in Marsh of the structures or functions of the “transmission device” and the “computing device”. It would appear from Marsh that the two devices are provided together and are, at the very least, inseparable. *See, e.g.,* Marsh, paragraph 21.

To be sure, the Examiner has not explained the feasibility of such a modification of Marsh. The Examiner relied on the secondary reference (Maltseff) to teach a field control device operatively connected to an asset management system and further the remote client computer system contains at least one interrogation device that is separate from the remote client computer. *See* Final Office Action, page 5. However, again, the Examiner provide no reasonable explanation or appropriate reason to modify Marsh. The Supreme Court has recently stated that the obviousness analysis should be explicit. *See KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) (“[R]ejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoting *In re Kahn*, 441 F.3d 977,988 (Fed. Cir. 2006)). In the present rejection, the Examiner has failed to meet this requirement of the obviousness analysis, and therefore has not established a *prima facie* case of obviousness. Appellants strongly believe that there is not an appropriate reason to modify Marsh in such a way as to read on independent claims 1 and 26. In view of the foregoing, Marsh cannot anticipate claims 1 and 26, or their dependent claims.

***Request Review of Final Rejections***

For the above reasons, Appellants respectfully request reviews of the Final Rejections prior to filing of an Appeal Brief in the present application.

Respectfully submitted,

Date: July 21, 2008

/Floron C. Faries/  
Floron C. Faries  
Reg. No. 59,991  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545